UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,612	10/06/2000	Eric C. Anderson	P203/1757P	1357

			EXAMINER
29141	7590	05/11/2004	YUSSUF, SAJID

SAWYER LAW GROUP LLP
P O BOX 51418
PALO ALTO, CA 94303

ART UNIT	PAPER NUMBER
2141	

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10/06/2000-03/05/2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 October 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2.   The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not

apply when the reference is a U.S. patent resulting directly or indirectly from an international

application filed before November 29, 2000. Therefore, the prior art date of the reference is

determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3.   **Claims 1-17, 19-32 rejected under 35 U.S.C. 102(e) as being anticipated by Safai et al.**

(6,167,469).

4.   As per claims 1,9,14,22, Safai teaches a method for reducing transmission bandwidth

requirements of a portable image capture device, including the means for establishing a

communications connection on a network, (See Column 3 Lines 47-55). Additionally, assigning an

image identifier to captured images uploaded to a server on a network wherein each of the images

are stored in an image file, (See abstract and Column 3 Lines 60-67), where each of the files having

a different size; wherein the file size is interpreted as the resolution in which a specific image was

captured. In response to a user request to apply an action to one of the uploaded images,

specifically a marked image. If marked, uploading or transmitting the image identifier of the image

to the server wherein the server performs the action on the image identified by the image identifier

thereby eliminating the need to retransmit the image and reducing transmission bandwidth, (See Columns 4 & 11 Lines 1-10 &10-14 respectively).

Transmitting the image and the image identifier from the image capture device to a server on the network for storage; wherein address is interpreted as any location on the network (which consists of servers) such as a URL, E-mail, or IP address, etc., (See Columns 3 & 4 Lines 64-67 & 1-19 respectively). Marking the image as sent in the image capture device, (See Column 10 Lines 60-67). Downloading the image identifier to the image capture device for association with the corresponding uploaded image, (See Column 15 Lines 27-45). Safai teaches a system for reducing storage and bandwidth requirements comprising of an online photo-sharing service for receiving digital images over a network and an image capture device for capturing digital images, where the image capture device includes a means for establishing a network connection, (See Column 1 Lines 10-18). Additionally he teaches a means for assigning an image identifier to each of the digital images, (See Column 11 Lines 10-14). A means for transmitting the digital images and the respective image identifiers from the image capture device to the server for storage, (See Columns 3 & 4 Lines 64-67 & 1-19). A means for marking the digital image as sent, (See Column 12 Lines 36-67). A means responsive to a user requests to perform an action on a selected image for determining if the selected image is marked and means responsive to the selected image being marked for uploading the selected image's image identifier and the action to the server, thereby eliminating the need to retransmit the image; wherein the marked image is interpreted as being sent to an "outbox" to indicate that the message with the selected pictures is stored in a separate data structure, (See Column 12 Lines 61-67).

5.   As per claim 2, Safai teaches the claimed invention as described in claim 1 above and furthermore discloses reducing the size for each of the image files corresponding to the uploaded images on the image capture device, thereby reducing storage requirements; wherein once the image is sent across the network the user is asked to delete the image (reduction of image files) and if deleted an association still exists between the sent picture and the image capture that sent the image (See Columns 4 & 10 Lines 1-27 & 24-39 respectively).

6.   As per claim 3, Safai teaches the claimed invention as described in claims 1-2 above and furthermore discloses uploading the image identifiers with the captured images, (See Column 4 Lines 10-13).

7.   As per claims 4 and 25, Safai teaches the claimed invention as described in claims 1-3 above and furthermore discloses deleting at least a portion of each of the image files; wherein deleting a portion is interpreted as deleting the image from the image capture device once loaded onto the server but retaining the association between the image and the image capture device, (See Columns 4 & 10 Lines 1-26 & 60-67 respectively).

8.   As per claims 5, 12, 17 and 26, Safai teaches the claimed invention as described in claims 1-4 above and furthermore discloses storing each of the captured images in an image file that includes a high resolution image, a reduced resolution image, and audio, (See Columns 11 Lines 27-39). Wherein replacing or deleting the high-resolution image and replacing it with a reduced resolution image, (See Columns 10 & 12 Lines 41-59 & 50-67). Furthermore, deleting the high-resolution image and audio, if audio has been recorded for the image; wherein a reduced image is interpreted as a thumbnail image. In relation to the image capture device the image file contains a reduced resolution image a high-resolution image and an audio file (if one exists) (See Columns 10 & 11 Lines 24-50 & 27-39 respectively).

9.   As per claims 6 and 13, Safai teaches the claimed invention as described in claims 1-5 above and furthermore discloses deleting the audio if audio has been recorded for the image and marking an "audio present" tag; wherein deleting the images can be interpreted as deleting all items related to a specific image which can be interpreted as deleting the audio as well, (See Column 12 Lines 1-14 & 50-60).

10.   As per claim 7, Safai teaches the claimed invention as described in claims 1-6 above and furthermore discloses that if the audio has been deleted the marking and "audio present" tag in the reduced image file; wherein the deletion is managed by the user therefore if the message containing an audio file is sent across a network the message is tagged as having audio present despite if the user decides to retain or delete the image, wherein if the user decides to delete the image/audio from the image capture device then the image/audio is deleted. On the server however, the image and audio exist with an "audio present" tag associated with the picture that has an audio file, (See Column 12 Lines 1-14, 50-60).

11.   As per claim 8, Safai teaches the claimed invention as described in claims 1-7 above and furthermore discloses replacing each of the uploaded images with an alias that includes the image identifier assigned to the uploaded image; wherein the alias/identifier is interpreted as an association of the image to the capture device, (See Column 4 Lines 1-19).

12.   As per claim 10, Safai teaches the claimed invention as described in claim 9 above and furthermore discloses reducing storage requirements of the image capture device by deleting the image form the image capture device, (See Column 10 Lines 60-67).

13.   As per claim 11, Safai teaches the claimed invention as described in claims 9-10 above and furthermore discloses the step of reducing storage requirements of the images capture device by replacing the image with a reduced image on the image capture device, the reduced image having a size substantially less than the size of the image, (See Column 10 Lines 24-50).

14.   As per claim 15, Safai teaches the claimed invention as described in claim 14 above and furthermore discloses digital images are stored in the image capture device as an image file, each of the image files including image data, reduced resolution image data, and metadata tags; wherein the image data is interpreted as a reduced resolution image (thumbnail), a high-resolution image, and an audio clip also known as metadata, (See Column 10 Lines 24-59).

15.   As per claim 16, Safai teaches the claimed invention as described in claims 14-15 above and furthermore discloses each of the transmitted digital images are replaced with reduced image files on the image capture device by deleting the image data from the image file, (See Columns 12 & 16 Lines 50-60 & 40-50 respectively).

16.   As per claim 19, Safai teaches the claimed invention as described in claims 14-18 above and furthermore discloses the image identifier and the action, the server applies the action to the digital image identified by the image identifier, (See Columns 13 & 14 Lines 48-67 & 1-25 respectively).

17.   As per claim 20, Safai teaches the claimed invention as described in claims 14-19 above and furthermore discloses that the server uses the image identifier to index and store the digital image, (See Columns 13 & 14 Lines 54-67 & 1-5 respectively).

18.   As per claim 21, Safai teaches the claimed invention as described in claims 14-20 above and furthermore discloses if an action requires retrieving the stored image, the server uses the image identifier sent with the action to retrieve the stored image, (See Column 15 Lines 27-45).

19.   As per claim 23, Safai teaches the claimed invention as described in claim 22 above and furthermore discloses sending the image identifiers to the image capture device to acknowledge receipt of the uploaded images; wherein acknowledgement can be performed before submission of the images/audio therefore if performed at the image capture device, it is interpreted that an acknowledgement is attained once images are sent across the network (See Column 9 Lines 30-67).

20.   As per claim 24, Safai teaches the claimed invention as described in claims 22-23 above and furthermore discloses images are stored in an image file, each of the image files having a particular size, wherein after receiving the image identifiers on the image capture device, reducing the size of

the image files uploaded to the server, thereby reducing storage requirements, (See Column 12 Lines 50-60).

21.   As per claim 27, Safai teaches the claimed invention as described in claims 22-26 above and furthermore discloses receiving a request from the user to listen to audio corresponding to the uploaded image, using the uploaded image identifier to retrieve the audio corresponding to the uploaded image, and downloading the retrieved audio to the image capture device for playing, (See Columns 6 & 15 Lines 19-37 & 27-45 respectively).

22.   As per claim 28, Safai teaches the claimed invention as described in claims 22-27 above and furthermore discloses encoding the audio into a higher compression format on the server to make the audio smaller for downloading and playing but without a noticeable loss of quality; wherein digitizing compresses or eliminates noise thereby reducing the size of the audio clip, (See Column 6 Lines 19-36).

23.   As per claim 29, Safai teaches the claimed invention as described in claims 22-28 above and furthermore discloses receiving a request to download a selected image, using the image identifier to retrieve the selected image and downloading the selected image, (See Column 15 Lines 27-45).

24.   As per claim 30, Safai teaches the claimed invention as described in claims 22-29 above and furthermore discloses receiving a password with the selected image and only retrieving the selecting image if the password is verified, (See Column 15 Lines 27-31).

25.   As per claim 31, Safai teaches the claimed invention as described in claims 22-30 above and furthermore discloses receiving a signature key with the selected image and only retrieving the selecting image if the signature key is verified; wherein the signature key is verified upon upload of the image, (See Column 4 Lines 1-15).

26.   As per claim 32, Safai teaches the claimed invention as described in claims 22-31 above and furthermore discloses receiving a request to delete a selected image and determining on the image capture device if the uploaded image on the image capture device should be deleted along with the selected image on the server; wherein if deletion occurs on a server or network the association is dissolved from the image capture device and the server. Therefore it is interpreted that if a user deletes an image from an image capture device and furthermore utilizes the image capture device to create a virtual photo album on the internet, then the pictures would be stored on one specific server where if the user decided to delete the image from the capture device the user would then have a choice to either delete the image from the server or retain the image through the use of the image capture device, (See Columns 10 & 15 Lines 60-67 & 27-45 respectively).

Claim Rejections - 35 USC § 103

27.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

28.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

    a.   Determining the scope and contents of the prior art.
    b.   Ascertaining the differences between the prior art and the claims at issue.
    c.   Resolving the level of ordinary skill in the pertinent art.
    d.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

29.   *Claim 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Safai et al. (6,167,469) in view of Hull et al (5,806,005).*

30.   As per claim 18, Safai discloses the claimed invention as described above. However, Safai does not explicitly teach that when the reduced image files are generated, the image capture unit determines whether a maximum number of images has been reached, then the oldest images are deleted to further increase storage capacity. Hull teaches a system for when the image files are generated, the image capture unit determines whether a maximum number of images has been reached, then the oldest images are deleted to further increase storage capacity, (See Column 2 Lines 38-45). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to enable an image overwriting method as taught by Hull in the system of Safai in order to prevent running out of image memory capacity or carry around extra storage mediums to store images on the image capture device, (See Column 3 Lines 1-9).

Response to Arguments

31.   Applicant's arguments filed 03/01/04 have been fully considered but they are not persuasive.

32.   As per claim(s) 1 Applicant states, "Safai may teach a camera that connects to a server and assigns image identifiers to captured images. However, Safai fails to teach or suggest only uploading the image identifier to the server, rather than the image itself, after the first time the image is sent in order to eliminate the need to retransmit the image."

33.   Examiner respectfully disagrees as the amended claims neither are narrow nor do they recite statements which clarify the scope of the invention. Furthermore, Safai does teach of only uploading the image identifier to the server and not the image after the image has been uploaded to the server the first time, (See Column 15 Lines 27-58). Specifically, Safai teaches of sending an image to the server and storing the image in a storage device, (See Column 15 Lines 27-35); wherein uploading the image to the storage device is the first time the image is sent to the storage (i.e., storage space on server). Safai then teaches of accessing the storage device or the camera itself to

transport the pictures for printing, (See Column 15 Lines 55-58). Therefore, it is inherent that when the user of the camera accesses the storage device in order to select the image, the identifier of the image has to exist in order to associate the image sent to the server with the image the user is trying to select; wherein if the user is trying to send a specific (one or more) image or images to a printing service an identifier inherently exists whether be it in a form of a number, name, or address to associate each and every image that is uploaded on the server with the user of the camera.

34.   As per claim(s) 1 Applicant states, "These passages of Safai disclose generating authentication information and an identifier for an image and storing the authentication information/identifier in the camera. Nowhere does Safai teach or suggest transmitting the information/identifier to the server. And even if Safai did teach that step, Safai further fails to teach or suggest that after the image is uploaded the first time, just the identifier is transmitted, rather than the image itself in order to eliminate the need to retransmit the image, as recited in claim 1."

35.   Examiner respectfully disagrees as Safai inherently teaches transmitting an identifier to the server as well as teaches that after the image is uploaded the first time, only the identifier is transmitted rather than the image itself in order to eliminate the need to retransmit the image. Safai teaches of sending an image to the server and storing the image in a storage device, (See Column 15 Lines 27-35); wherein uploading the image to the storage device is the first time the image is sent to the storage. Safai then teaches of accessing the storage device or the camera itself to transport the pictures for printing, (See Column 15 Lines 55-58). Therefore, it is inherent that when the user of the camera accesses the storage device in order to select the image, the identifier of the image has to exist in order to associate the image sent to the server with the image the user is trying to select; wherein if the user is trying to send a specific (one or more) image or images to a printing service an identifier inherently exists whether be it in a form of a number, name, or address to associate each and every image that is uploaded on the server with the user of the camera.

36.   As per claim(s) 9 & 14 applicant states "Safai fails to teach or suggest the steps of "determining if the selected image is marked; and if the selected image is marked, uploading the image identifier to the server, wherein the server performs the action on the image identified by the image identifier," as recited in independent claims 9 and 14.

37.   Examiner respectfully disagrees as regarding claims 9 and 14, Applicant asserts that Safai fails to teach or suggest the steps of "determining if the selected images is marked; and if the selected image is marked, uploading the images identifier to the server, wherein the server performs the action on the images identified by the images identifier." In general, the claimed limitations relate to nothing more than the ability to select an image, send the selected images' identifier to the server, and performing an action on the identified images.   Examiner submits that Safai unquestionably teaches these broad concepts as claimed. Safai taught the ability to select an image wherein a transport block received a photo selection from a user, and furthermore the transport application fulfilled the users request by selecting or deselecting the image by depicting a highlighted border around the picture, (see column 11, lines 1-14). Furthermore, after images were uploaded, a user could request services on the uploaded images by sending the selected images to a destination address whereby the server services the images by receiving and forwarding the photos, (see column 13, lines 10-24). Safai disclosed an exemplary service of printing the selected photos T-shirts, coffee mugs, and other products, wherein one or more of the photos received by the server could be printed upon request by an owner of the camera (see column 15, lines 45-58). Although not explicitly disclosed by Safai, the use of an image identifier in this case is inherent, as it is the only way to associate an image sent to the server and storing the image in a storage device, (See Column 15 Lines 27-35). Safai furthermore teaches of accessing the storage device or the camera itself to transport the pictures for printing, (See Column 15 Lines 55-58). Therefore, it is inherent that when the user of the camera accesses the storage device in order to select the image, the identifier of the image has to exist in order to associate the image sent to the server with the image the user is trying to select; wherein if the user is trying to send a specific (one or more) image or images to a printing service an identifier inherently exists whether be it in a form of a number,

name, or address to associate each and every image that is uploaded on the server with the user of the camera.

38.   As per claim(s) 9 & 14 applicant states "Safai actually teaches away from the present because when a user sends a request to the server to send an email with a particular image and the request and the image are transmitted to the server, that same image would be uploaded a second time if the user subsequently sent a second request to email the image. The present invention, in contrast, would reduce bandwidth in such a situation because when the user sent the second email request, the camera would only transmit the image identifier and the requested action to the server, but not the image."

39.   Examiner respectfully disagrees as Safai discloses the image or images that are uploaded to the server are stored in a storage area where the storage area holds the photos and inherently stores an association value (i.e., an identifier) in order for the user to be aware of the images uploaded. Safai unquestionably teaches these broad concepts as claimed. Safai taught the ability to select an image wherein a transport block received a photo selection from a user, and furthermore the transport application fulfilled the users request by selecting or deselecting the image by depicting a highlighted border around the picture, (see column 11, lines 1-14). Furthermore, after images were uploaded, a user could request services on the uploaded images by sending the selected images to a destination address whereby the server services the images by receiving and forwarding the photos, (see column 13, lines 10-24). Safai disclosed an exemplary service of printing the selected photos T-shirts, coffee mugs, and other products, wherein one or more of the photos received by the server could be printed upon request by an owner of the camera (see column 15, lines 45-58). Although not explicitly disclosed by Safai, the use of an image identifier in this case is inherent, as it is the only way to associate an image sent to the server and storing the image in a storage device, (See Column 15 Lines 27-35). Safai furthermore teaches of accessing the storage device or the camera itself to transport the pictures for printing, (See Column 15 Lines 55-58). Therefore, it is inherent that when the user of the camera accesses the storage device in order to select the image, the

identifier of the image has to exist in order to associate the image sent to the server with the image the user is trying to select; wherein if the user is trying to send a specific (one or more) image or images to a printing service an identifier inherently exists whether be it in a form of a number, name, or address to associate each and every image that is uploaded on the server with the user of the camera.

40.   Furthermore, Applicant asserts that Safai fails to teach or suggest a system wherein assignment of an image identifier is performed by the server, and then downloaded to the image capture device for association with the corresponding uploaded image.

41.   Examiner respectfully disagrees and submits that Safai disclosed the limitations as claimed. Safai discloses an embodiment in which image files can be uploaded to a Web site. Received images files are hyperlinked into an HTML file, and then made available worldwide through the network using standard WWW protocols (see column 14, line 59 through column 15, line 11). In this way, Safai discloses image identifier assignment by a server as claimed, as hyperlinking an image file by the Web site inherently associates an address with the file, thus providing an identifier for the image by the server. Furthermore, the HTML file used to navigate the uploaded image files contains the hyperlinks; the HTML file clearly is downloadable to the client for browsing as is commonly done in WWW protocols. Therefore Safai teaches the server assigning image identifiers (i.e., hyperlinks/addresses).
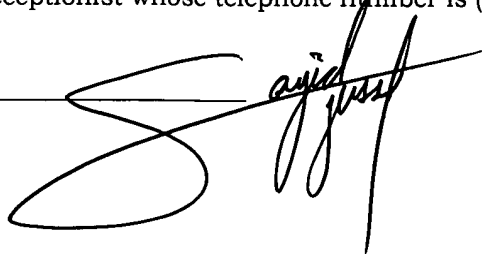
Conclusion

42.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

43.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

44.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajid Yussuf
Patent Examiner
Technology center 2100
6 May 2004

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER